

**REMARKS**

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner rejects claims 2-7 and 11-13 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,059,719 to Yamamoto et al., (hereinafter "Yamamoto"). Furthermore, the Examiner rejects claims 2-18 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2001/0053909 to Nakada et al., (hereinafter "Nakada").

In response, Applicant respectfully traverses the Examiner's rejections under 35 U.S.C. § 102(b) for at least the reasons set forth below. However, independent claim 13 has been amended to clarify its distinguishing features.

In the Official Action, the Examiner argues that both Yamamoto and Nakada disclose the loop section of a snare wire having a bent portion at a distal end of the loop section which is bent in a direction that intersects a plane formed by the loop section. The Applicant respectfully disagrees.

With regard to Yamamoto, the Examiner argues that the above features are found in Figures 9-12 and 15 and at column 10, lines 5-67 of Yamamoto. The same clearly show an incising member (93) which has the shape of a loop. However, the distal end of the loop is not shown or described as having a bent portion that is bent in a direction that intersects a plane formed by the loop. Column 10, lines 9-11 only describe the incising member as being shaped substantially like a circular loop. Although the loop of the incising member shown in Yamamoto is illustrated as being bent, the entire loop is bent from the proximal portion thereof (from the crimping clip which is not numbered in the Figures). The loop does not have a bent portion at the distal end which is bent relative to the plane of the

remaining portions of the loop (e.g., see Figures 2 and 3 of the present application where bent portion (7) is bent in a direction that intersects the plane formed by the snare wire loop (4)). The distal end of the incising member of Yamamoto does not deviate in direction from the plane of the loop in a manner as recited in independent claims 2 and 16.

With regard to Nakada, the Examiner argues that the bent portion of the loop section is shown in Figures 1 and 5-6. However, Figure 1 of Nakada does not show a snare and Figures 5 and 6 show the snare (16b) having a loop section substantially similar to that of Yamamoto. Namely, the loop section of Nakada does not have a distal end which deviates in direction from the plane of the loop as recited in claims 2 and 16 and shown by way of example at Figures 2 and 3 of the present application (where bent portion (7) is bent in a direction that intersects the plane formed by the snare wire loop (4)).

With regard to claim 13, the same has been amended to clarify that the loop section is pushed from the sheath such that a distal end bent section of the loop section is disposed at an intersection of the engagement projection and an inner wall of the cylindrical cap section (for example as shown in Figure 3 of the present application). The amendment to claim 13 is fully supported in the original disclosure, such as at Figure 3 of the Drawings. Thus, no new matter has been entered into the original disclosure by way of the amendment to claim 13.

Since, Yamamoto and Nakada do not disclose such a bent portion (as discussed above), they certainly do not disclose positioning such a bent portion in the manner now set forth in claim 13.

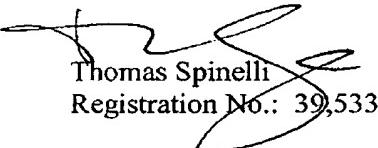
With regard to the rejections of claims 2-18 under 35 U.S.C. § 102(b), a medical instrument system, a method of assembling a medical instrument system and a

diathermic snare having the features discussed above and as recited in independent claims 2, 13 and 16, respectively, is nowhere disclosed in either Yamamoto or Nakada. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"<sup>1</sup> independent claims 2, 13 and 16 are not anticipated by either Yamamoto or Nakada. Accordingly, independent claims 2, 13 and 16 patentably distinguish over each of Yamamoto and Nakada and are allowable. Claims 3-12, 14, 15, 17, and 18 being dependent upon claims 2, 13 and 16, are thus at least allowable therewith.

Lastly, claim 2 has been amended to correct two minor grammatical errors therein. No new matter has been entered into the original disclosure in doing so.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

  
Thomas Spinelli  
Registration No.: 39,533

Scully, Scott, Murphy & Presser, P.C.  
400 Garden City Plaza, Suite 300  
Garden City, New York 11530  
(516) 742-4343  
TS:cm

---

<sup>1</sup> Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).